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LAWRENCE SUNG0- S2IPLAW, PLLC
401 9TH STREET, NW
SUITE 900-NIXON PEABODY LLP
WASHINGTON DC 20004-2128

In re Application of :
McMAHON *et al* :
Application No.: 10/588,840 :
PCT No.: PCT/US05/04518 :
Int. Filing Date: 10 February 2005 : DECISION
Priority Date: 10 February 2004 :
Atty. Docket No.: 044108.001000 :
For: PLANT NUTRIENT REDUCTION :
SYSTEM :

This is a decision on applicants' "PETITION UNDER 37 C.F.R. 1.47(a)" filed in the U.S. Patent and Trademark Office (USPTO) on 18 September 2007.

BACKGROUND

On 10 February 2005, applicants filed international application No. PCT/US05/04518 which claimed a priority date of 10 February 2004, and which designated the United States.

The deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was set to expire 30 months from the priority date, i.e. 10 August 2006.

On 08 August 2006, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee.

On 05 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that, *inter alia*, an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 18 September 2007, applicants filed the present petition which requests that the application be accepted without the signature of one of the joint inventors, Paul C. Porter on the grounds that he refuses to execute the application papers. The petition was accompanied by,

inter alia, a declaration of the inventors executed by inventor McMahon, a "DECLARATION OF ADAM C. BRINK IN SUPPORT OF THE PETITION UNDER 37 C.F.R. 1.47(a)" and the requisite petition and late declaration fees.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicants have satisfied items (1), and (3) above.

Concerning item (2) above, the petition asserts that the present application should be accepted for entry into the national stage based on the refusal of the co-inventor to join in the present application for patent. In this regard, section 409.03(d) of the Manual Of Patent Examining Procedure (MPEP), under the heading "REFUSAL TO JOIN" states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the application file reveals that item (2) cannot be said to have been satisfied at this time in that Mr. Brink's statement is insufficient. Specifically, it has not been established that a *bona fide* attempt was made to present Mr. Porter with a complete copy of the application

papers (specification, including claims, drawings, and oath or declaration). Additionally, it is unclear why no attempts were made to contact Mr. Porter, either in person or by mail, at his last known address.

With regard to item (4), the declaration of the inventors is not acceptable in that the name of the signing inventor does not correspond to that in the international application. Specifically, the declaration lists the signing inventor as T. Gordon McMahon while the international application lists the inventor as Gordon T. McMahon, and no explanation has been given for this discrepancy. As such item (4) cannot be said to have been satisfied.

Therefore, in that applicants have not satisfied items (2) and (4) above, the petition under 37 CFR 1.47(a) may not be properly granted at this time.

CONCLUSION

For the reasons above the petition is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

A proper response must include either (a) an acceptable declaration executed by all of the inventors, or (b) an acceptable showing that the missing joint inventor has refused to execute the application as discussed above and either an acceptable declaration executed by inventor McMahon or an explanation as to the discrepancy in the naming of inventor McMahon.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Mail Stop PCT, PO Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



Richard R. Cole
PCT Legal Examiner
Office of PCT Legal Administration

(571) 272-3281
Fax: (571) 273-0459